

## REMARKS

Claims 34-39 are currently pending in the current application. Each of claims 34-39 stand rejected by the October 16, 2008 Office Action. Claims 34 and 38 are amended by the present response. Applicants respectfully submit that no new matter is added by the amendments. Claims 34-36 are independent claims, and claims 37-39 depend, either directly or indirectly, from claim 36. Applicants respectfully request reconsideration of the Application, in light of the following remarks.

### Rejection of Claims 37-39 under 35 U.S.C. §112

Claims 37-39 stand rejected under 35 U.S.C. §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action discusses this rejection as follows:

Claims 37-39 recites transaction fee that reduces the promotion amount and is collected from the buyer or the first party. It is unclear how the transaction fee reduces the promotion amount. It is also unclear if an amount is collected from the buyer, which means the buyer is charged some amount of money, and this amount reduces the promotion amount, which means less promotional amount is applied to the purchase price. It is unclear what is considered "transaction fee."

(Office Action at p. 2.) Applicants respectfully traverse this rejection.

A rejection based on the failure to satisfy the requirement of "subject matter which applicants regard as their invention" is appropriate "only where applicant has stated, somewhere other than in the application as filed, that the invention is something different from what is defined by the claims." (MPEP § 2172.) The Office Action does not provide any assertion or explanation of how or where applicants have stated that the invention is something different from what is defined by the claims. Therefore, Applicants respectfully submit that the claims satisfy this requirement of 112.

Regarding the requirement to particularly point out and distinctly claim the invention, "[t]he essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." (MPEP §2173.02). Applicants respectfully submit that claims set out the particular subject matter with a reasonable degree of clarity and particularity.

As an initial matter, Applicants note that the identified “reduces the promotion amount” does not appear in either of claims 37 or 39, so it is not entirely clear to Applicants how the proposed reasoning of the Office Action applies to those claims. In any event, Applicants respectfully submit that the term “transaction fee” may be understood by its plain meaning – a fee charged for the performance of a transaction, or a service charge. Applicants also note that the term “transaction fee” is also in claim 36, which the Office Action does not reject under 35 U.S.C. §112, thereby showing the Office Action apparently recognizes the allowability of the term. In any event, transaction fees (or, put another way, service charges) are discussed in the specification as well. (See Specification, for example, at p. 14, 33-34.) Further still, claim 36 explicitly recites that the transaction fee is “associated with the online purchase request” further clarifying a transaction to which the transaction fee is related. As such, Applicants respectfully submit that the use of the term “transaction fee” does not violate the requirements of 35 U.S.C. §112.

Turning to the specific rejection of claims 37-39, the Office Action states, “It is unclear how the transaction fee reduces the promotion amount. It is also unclear if an amount is collected from the buyer, which means the buyer is charged some amount of money, and this amount reduces the promotion amount, which means less promotional amount is applied to the purchase price. It is unclear what is considered ‘transaction fee.’” Beginning with claim 37, that claim recites the method of claim 36 “wherein the transaction fee is collected from the buyer.” Applicant respectfully submits that for claim 37, it is clear that the fee is collected from the buyer. In other words, in claim 36, the buyer pays a transaction fee, or service charge. Claim 37 is not expressly limited in how that fee is collected from the buyer. For instance, to use an example from the specification, “[s]ervice charges can be applied to the issuer, or the issuer’s account, buyer’s account, and/or to the 3<sup>rd</sup> party seller’s web and application server 521.” (See Specification at p. 34; emphasis added.) Thus, as but one example, the fee could be collected directly from the buyer’s account. Regarding claim 37, other alternative methods of collecting the fee from the buyer could also be employed. As another example, “[t]he customer is also selectively made to pay a service charge to the system 15 for its seamless and automatic rebate and coupon redemption.” (See Specification at p. 14.) As but one more example, the fee could be collected by having the buyer pay an amount of money more than the “sales price less the promotion amount.” (See Specification at p. 34: “In addition, the issuer and/or **the buyer may pay more than the promotional amount and/or sales price less the promotional amount**, respectively...”; emphasis added.) Applicants

respectfully submit that, for claim 37, it is clear that the claimed transaction fee is collected from the buyer, and it is sufficiently clear what is considered a transaction fee to satisfy the requirements of 35 U.S.C. §112. Applicants respectfully request the withdrawal of the rejection of claim 37 on that basis.

Turning now to claim 38, Applicants respectfully submit that claim 38 depends from claim 37 and therefore expressly requires that the claimed “transaction fee is collected from the buyer.” Further, Applicants respectfully submit that it is not “unclear how the transaction fee reduces the promotion amount” as the Office Action asserts. In any event, claim 38 has been amended to clarify that, in claim 38, the transaction fee is collected from the buyer by charging an amount more than the sales price less the promotional amount. Support for this amendment can be found, for example, at p. 34 in the Specification (“...the buyer may pay more than the...sales prices less the promotional amount...”). Applicants respectfully submit that claim 38 satisfies the requirements of 35 U.S.C. §112 and request the withdrawal of the rejection of claim 38 on that basis.

Turning now to claim 39, that claim recites “the method of claim 36 wherein the transaction fee is collected from the first party.” As such, Applicants note that the claim explicitly recites that the fee is collected from the first party. As one example, the Specification, at p. 34, states that “[s]ervice charges can be applied to the issuer, or the issuer’s account, buyer’s account and/or to the 3<sup>rd</sup> party seller’s web and application server 521.” Thus, for instance, the transaction fee could be collected from the first party by charging an account of the first party. As another example provided in the specification, “The system 15 selectively charges the suppliers a transaction fee for generating their business.” (See Specification at p. 14.) For at least the foregoing reasons, Applicants respectfully submit that claim 39 satisfies the requirements of U.S.C. §112, and request the withdrawal of the rejection of claim 39 on that basis.

#### Rejection of Claim 34-39 as being anticipated by Meyer

Claim 34 stands rejected under 35 U.S.C. §102(e) as being anticipated by Meyer *et al.*, U.S. Patent No. 6,915,271 (hereinafter “Meyer”). Claim 34 has been amended for clarification purposes to make explicit what was previously implicit, namely, to recite “providing a portal containing a plurality of promotions wherein a buyer can search for a promotion from the first party associated with the item for sale after the offering by a second system of a second party.”

(Support for this amendment may be found in the Specification, for example, at Figs. 6-9 and the related text.) Applicants respectfully submit that Meyer does not teach or disclose, at least, “offering, by a second system of a second party, an item for sale online at a sales price amount” and “providing a portal containing a plurality of promotions wherein a buyer can search for a promotion from the first party associated with the item for sale after the offering by a second system of a second party.”

The Office Action asserts that Meyer discloses “offering, by a second system of a second party, an item for sale online at a sales price amount” at Figs. 31-35 and 39:55-41:22. (*See* Office Action at p. 3.) As indicated in the previous submission, for example, Figs. 31-35 illustrate incentives, not sales price amounts. Fig. 33, for instance, displays such incentives as “\$5 off Windsor Mugs” or “Free Beanie Baby with Toy Purchase.” Fig. 35, as another example, displays incentives showing a percentage or dollar amount off. Further, the “Buy Now” option in the cited portion of Meyer is, for example, “pressed from an incentive display.” (*See* Meyer at 40:64-65). As such, Applicants respectfully submit that Meyer’s use of a “buy now” option as part of a displayed incentive is different from “offering, by a second system of a second party, an item for sale online at a sales price amount” as claimed as described in claim 34 (which also explicitly requires “providing a portal....wherein a buyer can search for a promotion the first party associated with the item for sale after the offering by a second system of a second party...”), because, in the relied upon “buy now” example, any purported portal is provided before, and not after, any purported offering, by a second system of a second party, an item for sale online at a sales price amount.

Put another way, as discussed in the previous submission, in the presently claimed subject matter, the buyer can search for promotions associated with the item for sale, where the item has previously been offered for sale at a sales price amount (i.e., “after the offering...”) In contrast, the “buy now” feature of Meyer is presented as part of the incentive, and therefore the incentive of Meyer cannot be searched for as a promotion associated with an item for sale “after the offering...” To the extent Meyer, *arguendo*, would purportedly offer an item for sale at a sales price amount, that amount would not appear to be known or seen until after the incentive were located and the “buy now” feature selected. Thus, any search for a promotion in Meyer could not be associated with an item previously offered for sale. For at least that reason, Applicants respectfully submit that the cited portions of Meyer do not disclose each and every

limitation of claim 34, as arranged in claim 34, and therefore Meyer does not anticipate that claim. (See MPEP §2131.)

Turning now to claim 35, that claim recites a method of processing a promotion from a first party, the first party having a first system, the method comprising, *inter alia*, “receiving, by the second system, an online purchase request from a buyer for the item for sale; responding, by the second system, to the online purchase request by collecting from the buyer a purchase amount corresponding to the sales price amount less the promotion amount; and causing, by the second system, shipment by the second party of the item for sale to the customer.” Thus, claim 35 explicitly recites that the online purchase request is received by the second system (of the second party), the purchase amount is collected by the second system (of the second party), and shipment is by the second party.

Applicants respectfully submit that the Office Action does not present a *prima facie* case of anticipation at least because the relied upon teachings do not disclose every element of claim 35 as arranged as required by that claim. (See MPEP §2131.) For example, the Office Action relies on different systems and/or different parties to perform the purported receiving of a purchase request, responding by collecting a purchase amount, and causing shipment of the item.

For instance, the Office Action relies on Meyer at col. 41, lines 22-40, as disclosing “causing, by the second system, shipment by the second party of the item for sale to the customer.” (See Office Action at p. 3-4.) The cited portion of Meyer reads as follows:

In an alternate embodiment of the buy now procedure, the purchase screen is a pop-up that asks the member for all information necessary to complete the purchase (which may include the member's credit card number, address for shipping, and so on). When the member supplies the necessary information and clicks a “Confirm Buy Now” button, the service provider validates the credit card, and then sends the purchase order (including credit card number) electronically using a secure protocol to the vendor of the merchandise for processing. In an [sic] yet another alternate embodiment, the service provider actually charges the purchase to the member's credit card, and then informs the vendor of the transaction, giving the vendor all information necessary for the vendor to fulfill the purchase (i.e., to send the product to the member). The member then is provided with the necessary information to collect the goods or with a

confirmation that delivery will take place. Since an actual incentive redemption took place, the redemption recording activities described below also need to take place take place [sic]

Thus, in the cited portion, it is the “service provider” that “validates the credit card, and then sends the purchase order...”, and therefore, to the extent any aspect of the above cited portion of Meyers “receive[s]... an online purchase request from a buyer,” it is the “service provider.” However, in the above cited portion, it is the “vendor of the merchandise” that “fulfill[s] the purchase (i.e., [sends] the product to the member.)” Thus, the cited portion of Meyer does not teach the same party/system receiving the online purchase request from a buyer, **and** responding by collecting a purchase amount from the buyer, **and** causing shipment (by the same party), let alone “**receiving, by the second system**, an online purchase request from a buyer for the item for sale; **responding, by the second system**, to the online purchase request **by collecting from the buyer** a purchase amount corresponding to the sales price amount less the promotion amount; and **causing, by the second system, shipment by the second party** of the item for sale to the customer” as claimed.

Applicants now address the rejection of claim 36 (and claims 37-39 that depend from claim 36), which were also rejected as anticipated by Meyer. Independent claim 36 recites a method of processing a promotion for a first party, the method comprising, *inter alia*, “collecting, by the second system, a transaction fee associated with the online purchase request.” Applicants respectfully submit that Meyer does not disclose at least this aspect of claim 36. Applicants also note at this time that claim 36 also recites, for instance, a “purchase amount” that corresponds to “a sales price amount less the promotion amount.” Thus, claim 36 relates to, *inter alia*, a purchase amount, a sales price amount, a promotion amount, and a transaction fee, each of which are different aspects of claim 36.

The Office Action cites to Meyer at column 40, line 63 – column 41, line 20 as disclosing “collecting, by the second system, a transaction fee associated with the online purchase request.” (See Office Action at p. 4.). The cited portion of Meyer reads as follows:

Buy Now

When the “Buy Now” button is pressed from any incentive display, including a clipped incentive or an unclipped incentive, a

member may go to the site on the a [sic] Web for purchasing the good or service, which may be the same site one is on, or at a different Web location, or corresponding to an offline merchant that does nto have a Web site. In the preferred embodiment, when the Buy Now button is run, the Buy\_Now procedure shown as 1301 in FIG. 13 is run. Normally, at this stage, the entry for the incentive in INCENT-DB would already be accessed. As a first step, Buy\_Now examines whether the user is a member and if so, the incentive history entry for the incentive to make sure the member has clipped the incentive. If either the user is not a member or the incentive has not been clipped, the incentive is clipped by going to the procedure Clip\_Incentive of FIG. 6, a pop-up purchase screen then is displayed, which in [sic] the same frame as the incentive, and replaces the incentive frame. In an alternative embodiment a new pop-up window containing the purchase screen is displayed. The screen preferably includes hyperlinks to all the online merchants that carry the associated goods or services. By clicking on an online merchant link, the member is then automatically transferred to the online store and may purchase the goods or services. The list to display (including any merchant icons) are obtained from the list of POS entry in INCENT-DB 107.

As mentioned previously, the transaction fee is simply a fee charged for the performance of the transaction, or a charge for providing the service. As such, it is clearly distinguished from, as examples, a purchase amount, a sales price amount, or a promotion amount. Applicants respectfully submit the above cited portion is utterly silent with respect to such a transaction fee as claimed. A mere mention of, for example, a "Buy Now" button, a "purchase screen," or the "purchase [of] the goods or services" does not teach the collection of a fee for the performance of any identified transaction. For example, any asserted price for the purchase of a good is not a transaction fee, particularly where claim 36 also explicitly recites, for instance, a "purchase amount" (as well as a "sales amount") in addition to the "transaction fee." The cited portion of Meyer thus does not disclose a transaction fee, let alone collecting by the second system a transaction fee as claimed. Applicants respectfully submit that at least because the cited portions of Meyer do not teach "collecting, by the second system, a transaction fee associated with the online purchase request," that the Office Action does not present a *prima facie* case of anticipation, that Meyer does not anticipate claim 36, and that claim 36 (along with its dependent claims) is allowable over the cited art.

Applicants also submit that claims 37-39, which depend from claim 36, are further allowable for additional reasons. For example, the Office Action also asserts that, “[r]egarding claims 37-39, Meyer teaches wherein the transaction fee is collected from the buyer (*see* col. 40 line 63 to col. 41 line 20, col. 42 lines 1-41).” (*See* Office Action at p. 4.) With regard to claim 39, the Office Action’s offered rationale (“Meyer teaches wherein the transaction fee is collected **from the buyer**”) does not even apply to claim 39, which recites the method of claim 36 “wherein the transaction fee is collected **from the first party**.” As the “buyer” and the “first party” are separate entities, the teaching asserted by the Office Action does not teach the subject matter of claim 39 (assuming, *arguendo*, that Meyer teaches what the Office Action asserts – which Applicants respectfully disagree with, as discussed below), and Applicants respectfully submit that the Office Action does not present a *prima facie* case of anticipation, and that claim 39 is further allowable over the cited art.

Turning to claim 37 (which recites the method of claim 36 “wherein the transaction fee is collected from the buyer”), as well as claim 38 which depends from 37, Applicants respectfully submit that the first cited portion, reproduced and discussed above, is silent with respect to a transaction fee, let alone collection of a transaction fee from a buyer. The second cited portion, col. 42, lines 1-41, reads as follows:

...or more items (goods or services), before the total price is presented to the member by the merchant server, process MRCHNT in the merchant send to process SRVPRVD the consumer and goods information in the following form: A transaction ID number, member ID, and the goods or serves (GOS) order, which is the list of items and prices. Procedure Adjust\_Goods\_&\_Services\_Order procedure shown as 1401 in FIG. 14 is now run. Adjust\_Goods\_&\_Services\_Order first uses the member ID from the merchant placed cookie on consumer computer 115 checks that this is the member ID is valid. The procedure then accesses the ACCTPRVD process running on the member information computer 109, which looks up the member information in MMBR-DB 111 and transmits to process SRVPRVD the list of clipped incentives for that member, as determined by the process ACCTPRVD by looking up the ACCNT-DB part of MMBR-DB. Procedure Adjust\_Goods\_&\_Services\_Order now matches the member’s incentives against the GOS order provided by process MRCHNT, and for each match, computes the adjusted prices based on the incentives, thus



determining a modified GOS order which reflects the incentives having been applied. The modified GOS order identified by the transaction ID number is returned back to process MRCHNT in the merchant server when procedure Adjust\_Goods\_&\_Services\_Order terminates.

The merchant server now may transact the order. If the order is transacted, process MRCHNT in the merchant server sends information to the process SRVPRVD at the service provider that the transaction has been complete by calling on procedure Record\_Redemption shown as 1501 in FIG. 5. Record\_Redemption accesses SRVPRVD and records the redeem for each redeemed incentive in the modified GOS order. In particular, the member ID, the time/date, and the URL from which the member redeemed the incentive is recorded. The system then goes to the post redemption activities described below.

In some implementations, for example, if the merchant wishes not to allow the service provider to see and record the GOS order, process SRVPRVD sends the clipped incentives that are applicable to the items being purchased to process MRCHNT to computer the discount locally at the POS.

Applicants respectfully submit that the above cited portion is silent with respect to a transaction fee, let alone with respect to collecting, by the second system, a transaction fee associated with the online purchase request as claimed by claim 36 from which both claims 37 and 38 depend, let alone further with respect to wherein the transaction fee is collected from the buyer as required by claim 37, and let alone yet further still with respect to wherein the transaction fee is collected from the buyer by charging an amount more than the sales price less the promotional amount as required by claim 38. That the cited portion recites, for example, a “transaction ID number” or a “merchant server now may transact the order” does not teach a transaction fee as claimed. Again, the cited portion is silent with respect to any fee charged for the performance of the transaction (and distinguished from, for example, a sales price amount or a purchase amount), let alone to a transaction fee as claimed by claims 36, 37, or 38. Applicants therefore respectfully submit that claims 37-38 are further allowable over the cited art.

### Conclusion

In general, the Office Action makes various statements regarding the pending claims and the cited reference that are now moot in light of the above. Thus, Applicants will not address such statements at the present time. However, Applicants expressly reserve the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicants believe that the pending claims are allowable. Should the Examiner disagree or have any questions regarding this submission, the Applicant invites the Examiner to telephone the undersigned at (312) 775-8000.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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